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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,634	07/26/2001	Wei Yen	196.1004.01	8462

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EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,634

Applicant(s)

YEN ET AL.

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,15-22 and 36-46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,15-22 and 36-46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: see attached Office Action.

Art Unit: 2142

1. Claims 1, 15-22, and 36-46 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are more directed to Stripping Email Attachment From An Email And Adding a Web Page URL Into The Email To Fetch The Attachment.
3. Related applications mentioned in the Specification must be updated when their status change for example on page 6 of this application's Specification.
4. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide clear antecedent bases of each "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. **The following is a quotation of the second paragraph of 35 U.S.C 112:**

(2nd) The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(4th) Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.
6. Claims 43 and 44 are rejected under 35 U.S.C 112, second paragraph, and 35 U.S.C. 112, forth paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention and fails to further limit a previous claim since claim 12 has been cancelled. For compact prosecution, claims 43 and 44 shall be deemed dependent upon claim 1 unless otherwise notified by written communication to the Office.
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

Art Unit: 2142

8. Claims 1, 15-22, and 36-46 are rejected under 35 U.S.C. 102 (b) as being clearly anticipated by Beck et al. (United States Patent: 5,903,723).

9. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions. The claims recite to the generally well known inclusion of URLs into emails which point to a Web Site Page holding the attachment rather than emailing the whole of that Web Page content as an attachment and contents linked by sublinks therein. Thus the claims read on any email having a URL therein pointing to a Web Page (or Pages).

10. Per claim 1, Beck taught a method (e.g., see Title) for sending electronic mail (e.g., see Title), including:

- a) separating at least one attachment from a text portion (e.g., see figure 5 (401)) in an electronic mail message such that a link (e.g., see figure 4 (402 and/or 410) is created between said at least one attachment and said text portion (e.g., see Abstract and col. 5 (lines 6-33));
- b) delivering said at least one attachment at a time other than when said text portion is delivered (e.g., see figure 7 (707) and col. 14 (lines 11-16));
- c) using a non-email transfer protocol to deliver said at least one attachment (e.g., normal email uses SMTP port 25 while Web Servers use HTML and port 80 (or port 8080 for user/root privilege level port access rather than port 80 which was root only privilege level access under UNIX);
- d) selecting a preferred method for delivery (i.e., normal email path or HTML per col. 7 (line 54-et seq.) and/or col. 12 (line 51-et seq.) and also, Web Browsers could perform FTP and thus the URL could be of FTP:// and not HTTP://); and,
- e) making said at least one attachment available from said text portion (e.g., see figure 4 (402) and/or 625 of figure 6).

11. Per claim 15, see col. 7 (line 54-et seq.).

12. Per claims 16, 19, 20, 21, 43 and 44 see figure 6 for relative location of sender and recipient (note Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc., 67 USPQ2d 1132 (CAFC 2003)) (also, email from Sweden with the attachment stored on a United State based Web Server would be local to a United States based recipient) while keeping in mind that uploading the attachment to the server cached the attachment in that server rather than within, or in addition to, an email server with the WWW HTTP Web Server relative, or apart of, the recipient ownership and col. 7 (line 54-et seq.) for scanning and probing.

Art Unit: 2142

13. Per claim 17 and 18, each claim recites "combination of" which is an "or" condition and thus only one limitation per claim need be addressed by the applied reference such as in figure 6 (610 a gateway to the Internet for the sender).

14. Per claims 22 and 36-42, 45, and 46, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

15. The applicant's remarks with respect to pervious rejection(s) in examiner prior action have been fully considered but deemed moot in view of the above rejections.

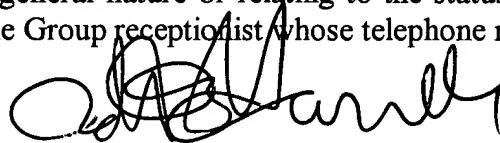
16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (571) 272-3896. The fax phone number for all papers is (703) 872-9306.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142